

REMARKS**Summary of the Final Office Action**

In the Final Office Action, claims 1-2 and 4-5 remain rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,125,091 to Kasuga. Claim 3 remains rejected under 35 U.S.C. § 103(a) as being unpatentable over Kasuga in view of U.S. Patent No. 5,619,521 to Tanaka.

Summary of the Response to the Office Action

Applicants have amended claims 1 and 4 to differently describe the invention. Accordingly, claims 1-5 remain pending for consideration.

Rejection under 35 U.S.C. §§ 102(e) and 103(a)

Claims 1-2 and 4-5 stand rejected under 35 U.S.C. § 102(e) as being anticipated by Kasuga. Claim 3 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Kasuga in view of Tanaka. To the extent that these rejections might still apply to the claims as newly-amended, they are respectfully traversed as follows.

At pages 4-5 of the Final Office Action, the Examiner states that “Applicant appears to be emphasizing the point that the substrate should not include any elements other than the light emitting portions. However, while such limitations may be required in the specification, the claims do not require this.” The Office Action goes on to state at page 5 that if Applicants wish to distinguish from Kasuga “more structural limitations must be added.” While Applicants still refer to the detailed distinctions and technical arguments presented in the previously filed Amendment dated September 22, 2003, Applicants have nevertheless newly-amended independent claims 1 and 4, in accordance with the Office Action’s suggestion, to even further distinguish the claims of the instant application from the Kasuga arrangement.

In particular, independent claim 1 has been newly-amended to recite that “the laser diode chip is provided separate from the portions of the optical pickup apparatus that are involved in guiding the emitted laser beams towards a recording surface of said recording medium.”

Moreover, independent claim 4 has been newly-amended to recite that “said light emitting device is provided separate from said optical system.” At least these particular features are neither shown nor suggested by Kasuga.

Accordingly, Applicants respectfully assert that the rejection under 35 U.S.C. § 102(e) should be withdrawn because Kasuga does not teach or suggest each feature of independent claims 1 and 4, as amended. As pointed out in MPEP § 2131, “[t]o anticipate a claim, the reference must teach every element of the claim.” Thus, “[a] claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. Verdegaal Bros. v. Union Oil Co. Of California, 2 USPQ 2d 1051, 1053 (Fed. Cir. 1987).” Furthermore, Applicants respectfully assert that dependent claims 2 and 5 are allowable at least because of their respective dependence from independent claims 1 and 4, as amended, and the reasons set forth above.

The Office Action applies Tanaka as a secondary reference in combination with Kasuga in its rejection of claim 3 under 35 U.S.C. § 103(a). This combination rejection is respectfully traversed at least because Tanaka does not cure the deficiencies of Kasuga discussed above with regard to independent claim 1. MPEP § 2143.03 instructs that “[t]o establish prima facie obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. In re Royka, 409 F.2d 981, 180 USPQ 580 (CCPA 1974).” Accordingly, withdrawal of the rejection under 35 U.S.C. § 103(a) is respectfully requested.

CONCLUSION

In view of the foregoing, Applicants respectfully request entry of this Amendment to place the application in clear condition for allowance or, alternatively, in better form for appeal. Applicants also request the Examiner's reconsideration and the timely allowance of the pending claims. Should the Examiner feel that there are any issues outstanding after consideration of this response, the Examiner is invited to contact Applicants' undersigned representative to expedite prosecution.

EXCEPT for issue fees payable under 37 C.F.R. § 1.18, the Commissioner is hereby authorized by this paper to charge any additional fees during the entire pendency of this application including fees due under 37 C.F.R. §§ 1.16 and 1.17 which may be required, including any required extension of time fees, or credit any overpayment to Deposit Account 50-0310. This paragraph is intended to be a **CONSTRUCTIVE PETITION FOR EXTENSION OF TIME** in accordance with 37 C.F.R. § 1.136(a)(3).

Respectfully submitted,

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